

IN THE CLAIMS

Please cancel claims 11 to 20 in accordance with the Office Action at p. 2.

REMARKS

**Indefiniteness Rejection**

Claims 8 to 10 were rejected under 35 U.S.C. § 112, second paragraph. (Office Action at p. 2). In making the rejection, the Office asserted that the phrase "provide "a more pleasant odor" is indefinite. (*Id.*). The Office reasoned that this was so because it was a "relative term." (*Id.*). The Office further stated that the phrase "was not "defined" by the claim, that no "standard for ascertaining the requisite degree" was provided by the specification, and that one of skill in the art would not "reasonably be apprised of the scope of the invention." (*Id.*).

For the reasons set forth below, the rejection respectfully is traversed.

Claims 8 to 10 recite that the fragrance "provide[s] a more pleasant odor." There is nothing vague or indefinite about that phrase. One skilled in the art would readily recognize what is being claimed as that is what fragrances inherently do - provide more pleasant odors. Nothing more is required, and the Office has not articulated any facts to support the rejection.

To reject a claim under the second paragraph of 35 U.S.C. §112, it is incumbent on the Office to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. *Ex parte Wu*, 10 U.S.P.Q.2d

2031, 2033 (B.P.A.I. 1989). This, the Office has not done. The Office has not made any factual determination that establishes that one of ordinary skill in the art would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims based upon the phrase provide "a more pleasant odor" as used in claim 8 to 10. Relative terms are not *per se* indefinite. And merely characterizing the disputed phrase as "a relative term" does not satisfy the Office's burden. For this reason alone, the rejection cannot stand and should be withdrawn.

Moreover, even if the Office had met the requisite factual burden, which it is denied, the Office's arguments in support of the rejection are not supported by law or fact. As to the Office's argument that "the phrase 'a more pleasant odor' is not defined in the claim," there is absolutely no requirement in patent law that claims provide definitions for terms used therein. And as shown above, considered as a whole, the terms of the claim are definite. For this further reason, the rejection cannot stand and should be withdrawn.

The second argument, i.e., the specification does not provide a standard for "a more pleasant odor" is also factually deficient. The Office is directed to Examples 1 to 2 of the captioned application. In particular, Example 1 sets forth a working example containing a fragrance present in an amount of 0.25% of the aerosol formulation, and Example 2 sets forth a working example containing a fragrance present in an amount of 2.5% of the aerosol formulation. It is, therefore, submitted that there is a standard for ascertaining the requisite "degree" in the captioned application. But the claims are not required to be limited to that illustration. For this further reason, the rejection cannot stand and should be withdrawn.

Finally, submitted in Appendix A is a Webster's dictionary definition from the internet of the term "fragrance", to wit, "something compounded to give off a sweet or pleasant odor." This further illustrates the definiteness of the objected to phrase. Thus, for all of the reasons set forth above, it respectfully is submitted that the rejection of claims 8 to 10 for this reason should be withdrawn.

### **Anticipation Rejection**

Claims 1 to 10 were rejected under 35 USC § 102 (b) as anticipated by Nakane, et al., U.S. Patent No. 5,122,418 ("Nakane"). (Office Action at pp. 3-4).

Nakane reportedly discloses a "composite" powder of an inorganic or organic core powder that is reportedly covered with one or more types of organic, inorganic or metallic powders. See, e.g., Abstract. The "composite" powder of Nakane reportedly can be used as a skin treatment agent, in make up, as a sunburn-preventing agent or as a deodorant. (*Id.*). In one embodiment of Nakane, there reportedly is disclosed a deodorant comprising a composite powder comprised of a "synthetic resin powder" and a "hydroxyapatite." (Col. 5, Ins. 15-20). Nakane further reportedly discloses that the composite powder can comprise a "metal oxide," in place of the hydroxyapatite. Nakane reportedly discloses that "the deodorant can be used in the form of, for example, aerosols, roll-ons, powders, lotions, creams, sticks, and other external deodorants, and further, shoe lining and household use type deodorants." (Col. 6, Ins. 3 to 11). Nakane also reportedly discloses a number of examples. Examples 30 to 40 generally reportedly disclose deodorant sprays and powders. More specifically, Examples 30 and 31 reportedly disclose aerosol deodorant sprays, yet make no mention of zinc oxide. Examples 32 to 34 reportedly are powders and make no mention of zinc oxide. Example 35 reportedly discloses a deodorant spray containing the "composite" powder including zinc oxide in a 20

gram to 80 gram ratio to nylon in the composite powder and the powder is reportedly present in an amount of 1.5% of the composition. Thus, the zinc oxide reportedly is present in an amount of 0.3%. Further, the deodorant was reportedly applied under the test subject's arm. Example 36 discloses another spray reportedly containing zinc oxide present in an amount of 0.24% based on the composition of the Example. Examples 37 to 40 reportedly further disclose deodorant powders, yet only examples 37 and 38 mention zinc oxide.

In making the rejection, the Office Action stated that "Nakane disclose[s] micronized zinc oxide products comprising a thickening agent such as silica or silicates, a fragrance such as absolute Jasmine or lavender oil (see abstract, col 5, lines 36-65; col 6, lines 1-11; col 9, lines 13-31; col 10, line 19-22, 45-51; col 9, lines 40 to 50; col 12, lines 9-12, lines 23-25; col 13, lines 29-30; examples 30-40)." (Office Action at p. 3). The Office Action further contended that "[the amount of zinc oxide used in Nakane's compositions falls within the same range as instantly claimed (see col. 10, lines 58-61; examples 35-38)." (*Id.*). The Office futher stated that "Nakane's composition also comprise a propellant as an aerosol deodorant spray and can be used for spraying on the body, therefore, they meet the limitations of the instant usage." (*Id.*) The Office then concluded that "Nakane's composition anticipate the limitations of the instant claims." (Office Action at p. 4).

For the reasons set forth below, the rejection, respectfully is traversed.

As is well settled, anticipation requires "identity of invention." *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 U.S.P.Q.2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claim. *In re Marshall*, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978); *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Furthermore, in a § 102 (b) rejection

there must be no difference between what is claimed and what is disclosed in the applied reference. *In re Kalm*, 154 U.S.P.Q. 10, 12 (C.C.P.A. 1967); *Scripps v. Genentech Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Moreover, there is a "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103. . . ." *In re Warner*, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967), cert. denied, 389 U.S. 1057 (1968).

Initially, it is noted that the Office did not identify where in Nakane there is disclosed a solvent as is required by claim 1. And, to the extent that Nakane does disclose any ingredients that may be a solvent, which it is not admitted that it does, the Office has not identified any such ingredients. Thus, the rejection fails to provide the requisite factual basis to sustain a rejection for anticipation. Moreover, the rejection fails to identify where in Nakane each and every limitation of the claims and arranged as in the claims is shown. This is insufficient as a matter of law to support a conclusion of anticipation, and for this reason alone, the rejection should be withdrawn.

Aside from that, the Office Action impermissibly picks and chooses from the various sections of the disclosure of Nakane to arrive at the claimed invention. See, for example, the citation to "see abstract, col 5, lines 36-65; col 6, lines 1-11; col 9, lines 13-31; col 10, line 19-22, 45-51; col 9, lines 40 to 50; col 12, lines 9-12, lines 23-25; col 13, lines 29-30; examples 30-40)." (Office Action at p. 3). The Office Action impermissibly relied on the shotgun disclosure of Nakane to arrive at the claimed invention by picking and choosing so much of the reference as it needs from the various portions of Nakane to arrive at the claimed invention. Yet, nowhere does the Office disclose where Nakane discloses each and every limitation arranged as in the claims. Thus, for this further reason, the rejection should be reversed.

Futhermore, the rejection based upon the examples of Nakane is factually deficient. Examples 30 and 31 reportedly disclose aerosol deodorant sprays, yet make no mention of zinc oxide or a solvent. Thus these examples are irrelevant to the claims of the instant invention.

Examples 32 to 34 reportedly are powders and make no mention of zinc oxide or a solvent. So too, this renders these examples irrelevant to the patentability of the instant invention.

Examples 35 and 36 reportedly disclose a deodorant spray containing the "composite" powder where the zinc oxide reportedly is present in an amount of 0.3% and 0.24%, respectively. Yet the Office Action did not identify where there is a solvent in either of these compositions. Further, the deodorant spray was reportedly applied under the test subject's arm. This disclosure has nothing to do with a pressurized aerosol for "treating foot and/or shoe odors" as is required by the instant claims and exemplified by the Examples in the specification. Accordingly, these examples of Nakane do not anticipate the instant invention.

Finally, examples 37 to 40 reportedly further disclose deodorant powders. It respectfully is submitted that these powders are irrelevant to a pressurized aerosols for treating foot and/or shoe odors of the present invention as no solvent is present.

Thus, for all of the foregoing reasons, it respectfully is submitted that the rejection of claims 1 to 10 over Nakane should be reversed.

### **Obviousness Rejection**

Claims 1 to 10 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Lajoie, U.S. Patent No., 5,466,470 ("Lajoie"), in view of Lisboa, U.S. Patent No. 5,679,324 ("Lisboa"). (Office Action at pp. 4 to 5.). For the reasons set forth below, the rejection respectfully is traversed.

Lajoie reportedly discloses a "co-micronized" bicarbonate salt composition comprising a blend of ingredients that can include, *inter alia*, zinc oxide as one of many choices of ingredients. The Office Action alleges that Lajoie also discloses "thickeners, surfactants and fragrances" in Examples 3 and 4. Lajoie does not disclose, a fact the Office admits, any aerosol formulations.

Lisboa reportedly discloses "cosmetic aerosol foams" for shaving. The compositions of Lisboa may contain any number of additional ingredients. Lisboa reportedly states that zinc oxide may be present as a "sunscreen active agent." Col. 8, Ins. 11 to 21).

In making the rejection, the Office asserted that Lajoie teaches co-micronized bicarbonate salts and zinc oxide, in addition to "thickeners, surfactants and fragrances." (Office Action at p. 4). The Office acknowledged, however, that Lajoie differs from the presently claimed invention in that it does not disclose a pressurized aerosol formulation. (*Id.*).

To fill the acknowledged gap, the Office relied upon Lisboa as teaching the desirability of aerosols. (*Id.* at p. 5).

The Office then concluded that "it would have been obvious to one of ordinary skill in the art at the time of the invention to add a propellant, such as those taught by Lisboa, to the compositions of Lajoie and formulate an aerosol topical delivery system of Lajoie's compositions, because one of ordinary skill in the art would have had a reasonable expectation to succeed in formulating aerosolized formulations that are easy to use and more appealing to the general consumers." (*Id.*).

The Office Action states that Lajoie discloses "[t]hickeners, surfactants and fragrances" in examples 3 and 4. The Office Action does not, however, state what particular ingredients in these particular examples are a thickener, surfactant or fragrance. Thus, applicants are left to speculate what particular ingredients of Lajoie

the Office is asserting act as a "thickener, surfactant or fragrance." Indeed, the Office Action itself speculates that these ingredients act as a "thickener, surfactant or fragrance."

Obviousness, however, cannot be based upon speculation. Nor can obviousness be based upon possibilities or probabilities. As is fundamental, a *prima facie* case of obviousness must be based on facts. *In re Freed*, 165 U.S.P.Q. 570, 571-72 (C.C.P.A. 1970). When the rejection is not supported by facts, it cannot stand. *Ex parte Saceman*, 27 U.S.P.Q.2d 1472, 1474 (B.P.A.I. 1993).

The rejection impermissibly speaks in generalities and makes allegations with regards to the disclosure of Lajoie, yet points to no specific facts to support those allegations, e.g. what particular ingredients have these characteristics in examples 3 and 4 of Lajoie. And it is not the applicant's burden to try to ascertain what ingredients in the Examples of Lajoie have which characteristics. Thus, the rejection is not supported by the kind of specificity required to sustain a conclusion of obviousness. *Ex parte Humphreys*, 24 U.S.P.Q.2d 1255, 1262 (B.P.A.I. 1992). ("The Examiner's rejection is not specific as to how one of ordinary skill in the art would have found it (the claimed invention) obvious. . . ."). For this reason alone, the rejection should be withdrawn.

Furthermore, the Office Action alleges that Lisboa "teaches propellant containing topical cosmetic or therapeutic compositions .... Lisboa suggests that the use of aerosol compositions gaining wide appeal among both men and women as they are easy to use." (Office Action at p. 5). However, Lisboa states in full that "cosmetic aerosol foam compositions, **particularly those used in association with shaving** are well known in the art. Aerosol shaving compositions such as shaving creams and shaving gels have been used for a number of years, with aerosol shaving gels recently gaining wide appeal among both men and women." (emphasis

added) Col. 3, Ins. 16 to 22. Lisboa does not state some general desirability of formulations containing a propellant, but mentions aerosol shaving creams and shaving gels "gaining wide appeal among both men and women." For this further reason, the rejection is not based on facts and should be withdrawn for this further reason alone.

The Office Action further states that Lisboa "teaches that the use of propellants in preparing aerosol formulation containing various cosmetically suitable ingredients is conventional." The Office Action does not cite where in Lisboa this assertion is made. Again, applicants are left to guess what portion of the disclosure of Lisboa the Office is relying upon as there is no citation to any portion of Lisboa to support this assertion.

That notwithstanding, the mere assertion by Lisboa that shaving creams utilizing a propellant are "well known" is not statutory prior art. To treat Lisboa's statement, with regards to shaving cream, and then to extend it as such to foot and shoe deodorants, would render every propellant containing composition in the world as obvious. Surely Lisboa does not have such an effect, let alone such an effect as statutory prior art. As the precedent above clearly establishes, an obviousness rejection must be based on facts - not generalities. For this further reason, the rejection should be withdrawn.

Moreover, to the extent the Office contends that the disclosure of Lisboa that the use of propellants in shaving creams is "conventional," this too does not establish a *prima facie* case of obviousness *per se*. As the Federal Circuit has stated:

[V]irtually all [inventions] are combinations of old elements.  
Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983)  
('Most, if not all, inventions are combinations and mostly of old elements.'). Therefore an examiner may often find every element of a

claimed invention in the prior art. If identification of each element were sufficient to negate patentability, very few patents would ever issue.

*In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Thus, whether or not a claim limitation recites the use of an "old" or "conventional" element, that fact does not render the claims as obvious *per se*, and impermissibly ignores the other limitations of the claim. And, as the Office is no doubt aware, there are no *per se* rules of patentability. *In re Ochiai*, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995).

Aside from the factual deficiencies set forth above, it respectfully is submitted that the Office Action did not set forth a *prima facie* case of obviousness. A *prima facie* case of obviousness requires that the rejection describe with specificity why one skilled in the art would have combined two references to arrive at the claimed invention. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.". ). In the present case, no such explanation is found in the rejection. The Office cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would "impel" one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301-1302 (B.P.A.I. 1993). The Office was required to demonstrate where in Lisboa and Lajoie there is a suggestion which would have "strongly motivated" one to make the compositions as claimed. *Ex parte Graselli*, 231 U.S.P.Q. 393, 394 (Bd. App. 1986), and the type of suggestion that the changes "should" be made. *Ex parte Markowitz*, 143 U.S.P.Q. 303, 305 (Bd. App. 1964). The rejection fails to provide any specific reason why one would be motivated, let alone impelled, to combine Lisboa with Lajoie, in the manner

suggested by the Office. Thus, the rejection fails to set forth the required facts and reasoning required to support a *prima facie* case of obviousness. Accordingly, it respectfully is submitted that the rejection of claims 1 to 10 for this basis should be withdrawn.

Moreover, claims 1 to 10 require that the aerosol be an aerosol for treating foot and/or shoe odors. The rejection fails to identify where in Lajoie or Lisboa such a limitation can be found. Indeed, as is fundamental, all properties and attributes of a claimed invention must be considered by the Office. *In re Antonie*, 195 U.S.P.Q. 6, 8 (C.C.P.A. 1977). For this further reason, the rejection should be reversed.

Regarding the Office Action's contention that the skilled artisan would have had a reasonable expectation of success in formulating aerosolized formulations "that are easy to use and more appealing to the general consumers," applicants respectfully disagree with this contention. In order for a reference to provide a reasonable expectation of success, the references themselves must provide such an expectation in addition to the suggestion to combine. *In re Dow Chemical*, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988). The applicant's own disclosure may not be the source of a reasonable expectation of success. The only facts the Office Action pointed to was a statement in the "background" of the invention of Lisboa that aerosol foam compositions are well known, and some general conclusion that there is a need for formulations that "are easy to use and are more appealing to the general consumers." This standard for a reasonable expectation of success or a motivation to combine is not found in either of the references, and is thus not of record, and is contrary to the law of obviousness. "Ease of use" and "appeal" to consumers is no substitute for a disclosure in the art that one would have had a reasonable expectation of success in formulating the aerosol formulations containing the particular ingredients recited in the claims of the present invention.

Accordingly, for the reasons set forth above, entry of the amendments, withdrawal of the rejections, and allowance of all of the pending claims respectfully is requested. If the Examiner has any questions regarding this paper, please do not hesitate to contact the undersigned attorney.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231, on 10/13/02.

Robert J. Lipka

Respectfully submitted,

By:

Robert J. Lipka  
Robert J. Lipka  
Registration No. 42,807  
SCHERING-PLOUGH CORPORATION  
2000 Galloping Hill Road  
Kenilworth, New Jersey 07033  
(908) 298-5056